



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,419	10/22/2003	Kevin G. Currans	1000 1596-6	8513
22879 7590 07/10/2009 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
07/10/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

ipa.mail@hp.com

jessica.l.fusek@hp.com

### Office Action Summary

**Application No.**

10/692,419

**Applicant(s)**

CURRANS ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15, 20, 22 and 24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 15, 20, 22 and 24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicant's amendment filed on April 7, 2009 is hereby acknowledged, Claims 15, 20, 22 and 24 have been examined.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2009 has been entered.

### ***Response to Arguments***

3. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15, 20, 22 and 24 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.
5. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

6. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.
7. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.
8. In this particular case, claim 15 fails prong (1) because the “tie” (e.g. consumable item ) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.
9. Claims 20,22, and 24 are either dependant upon claim 15 or contain similar limitations and are rejected for at least the same reasons.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 15, 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Briscoe. (US Patent 6,341,273) in view of Berstis et al. (US Patent 6,282,653) and  
further in view of Cordery (US Patent 5,655,023)

12. As per claims 15 and 20,

Briscoe ('273) discloses a method of exchanging payments, comprising the steps of:  
purchasing a consumable article having a consumable item therein configured to allow  
recreation of royalty based content; (Column 6, lines 49-58)  
creating a digital cash account for the consumable item having an amount proportionally  
related to the amount of the consumable item; (Column 5, lines 12-31)  
expending a portion of the consumable item with the consumable article wherein the use of  
the consumable item to recreate the royalty based content  
incurs [[a]]the debit charge; (Column 6, lines 8-46)  
reducing the amount of the digital cash account over a network by the  
amount of the debit charge incurred; (Column 6, lines 8-46)

13. Briscoe ('273) does not explicitly disclose

preventing the use of the consumable item by a valve in proportion to the reduced amount  
of the digital cash account of the consumable item, thereby bartering a portion of the  
consumable item for the use of the content; Courdrey et al. ('023) discloses preventing the  
use of the consumable item by a valve in proportion to the reduced amount of the digital  
cash account of the consumable item, thereby bartering a portion of the consumable item

for the use of the content;( Column 7, line 47 – column 8, line 5; and figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Briscoe ('273) method with the Courdrey et al. ('023)method in order to recoup the expense of product development. Examiner notes a thereby clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)

14. Briscoe ('273) does not explicitly disclose acquiring, a first royalty based content that indicates an owner of the content and the amount of a debit charge for using the content; and updating a digital cash account over a network for the owner of the royalty based content by the amount reduced from the digital cash account for the consumable item.
15. Berstis et al. ('653) discloses acquiring, a first royalty based content that indicates an owner of the content and the amount of a debit charge for using the content; and updating a digital cash account over a network for the owner of the royalty based content by the amount reduced from the digital cash account for the consumable item. (Abstract, Column 6, line 43 – Column 7 line 29, discussion of royalty payment for usage –prepaid amount to reduce pre rendering of content ) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Briscoe ('273) method with the Berstis et al. ('653) method in order to recoup the expense of product development
16. Claims 15 is in parallel with claim 20 and are rejected for at least the same reasons.

17. As per claim 22

Briscoe ('273) discloses an apparatus including a consumable item using the method of claim 15 to exchange payments. (Abstract)

Claims 24 is in parallel with claim 22 and are rejected for at least the same reasons.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number:  
10/692,419  
Art Unit: 3685

Page 7

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685